

REMARKS / ARGUMENTS

I. General Remarks

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application, including the references that Applicants have submitted in this case.

II. Disposition of Claims

Claims 1-83 are pending in this application.

Claims 3, 8, 10, 13, 16, 21, 26, 32, 34, 44, 58, 60, 61, 65, and 66 have been amended herein. These amendments are supported by the specification as filed. It should not be assumed that any of these amendments are made for reasons relating to patentability.

Claims 1-23, 26/23, 27-32, and 35-63 stand rejected under 35 U.S.C. § 102(b). Claim 49 stands rejected on the ground of nonstatutory obviousness-type double patenting. Claims 1-83 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting. The Office Action has objected to claims 58 and 60.

III. Objections to Claims

The Office Action has objected to claim 58, and requested that the term “wherein the enhancer” be inserted after “method of claim 56” in order to define what has the formula listed in that claim. The Office Action also has objected to claim 60 and requested that it be amended to depend from claim 59 to provide antecedent basis for “the proppant”. Applicants have amended claims 58 and 60 in accordance with the Examiner’s requests, and thus respectfully request withdrawal of these objections.

IV. Rejections of Claims

A. Rejections of Claims Under 35 U.S.C. § 102

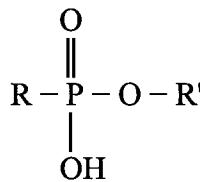
Claims 1-23, 26/23, 27-32, and 35-63 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,807,812 to Smith *et al.* (“Smith”). With respect to these rejections, the Office Action states:

Smith *et al.* discloses, with respect to claims 1 and 42, a method of fracturing a portion of a subterranean formation comprising: providing a gelled liquid hydrocarbon fracturing fluid comprising a gelling agent that comprises a polyvalent metal salt of a phosphonic acid ester, and contacting the portion of the subterranean formation with the gelled hydrocarbon fracturing fluid under conditions effective to create or enhance at least one

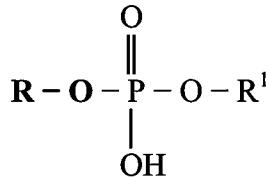
fracture in the subterranean formation. With respect to the depending claims, the reference teaches the limitations as claimed. See the entire document, especially the abstract, col. 3, line 11 – col. 5, line 43, col. 6, line 23- col. 7, line 7, tables, and examples.

(Office Action at ¶ 4.) Applicants respectfully disagree with these rejections.

In order to form a basis for a rejection under 35 U.S. C. § 102(b), a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 2131 (2006). Applicants respectfully submit that *Smith* does not disclose a gelling agent that comprises a polyvalent metal salt of a phosphonic acid ester, as recited in claims 1 and 42. Phosphonic acid esters, as recited in Applicants’ claims, generally have the formula:



wherein R and R' comprise hydrocarbon groups. Rather, *Smith* discloses metal salts of phosphoric acid esters (specifically, “orthophosphate esters”) having the formula:



(*Smith* at col. 5, ll. 25-32 (emphasis added); *see id.* at col. 3, ll. 14-16 & 43-65.) Salts of these phosphoric acid esters cannot anticipate the polyvalent metal salts of phosphonic acid esters in Applicants’ claims.

Moreover, with respect to claims 7, 49, and 51, Applicants respectfully submit that *Smith* does not disclose phosphonic acid esters having the specific formulae recited in these claims. Therefore, *Smith* cannot anticipate claims 7, 49, and 51.

Therefore, because *Smith* does not teach and does not disclose phosphonic acid esters having the formula recited in claims 1 and 42, Applicants respectfully assert that *Smith* does not disclose each element of claims 1 and 42. Thus, *Smith* cannot anticipate these claims, and claims 1 and 42 are allowable over *Smith*. Moreover, since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and

since claims 2-23, 26/23, 27-32, and 35-41, and 43-63 depend, either directly or indirectly, from independent claim 1 or 42, these dependent claims are allowable for at least the same reasons, in addition to the reasons discussed above with respect to claims 7, 49, and 51. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicants respectfully requests the withdrawal of these rejections

B. Double-Patenting Rejections

Claim 49 stands rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,511,944. Submitted herewith is an appropriate terminal disclaimer in compliance with 37 C.F.R. § 1.321 disclaiming the appropriate term. Accordingly, Applicants respectfully submit that the double patenting rejections have been overcome, and respectfully request the withdrawal of these rejections.

V. Provisional Rejections of Claims

Claims 1-83 stand provisionally rejected over claims 1-14, 38-45 and 50-68 of U.S. Patent Application Serial No. 10/409,240 and claims 1-74 of U.S. Patent Application Serial No. 10/839,433. While not acquiescing with the merits of these provisional rejections, Applicants acknowledge these provisional rejections, and will respond to the merits of the rejections and/or provide any necessary terminal disclaimers once the underlying patent applications issue as patents.

VI. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The amendments and example distinctions discussed by Applicants are sufficient to overcome the rejections of the claims.

SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this

application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

The Commissioner is hereby authorized to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.1041, in the amount of \$130.00 for the terminal disclaimer fee under 37 C.F.R. § 1.20(d). Should the Commissioner deem that any additional fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.1041, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



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